

AF  
2871



503.36984X00

#20/Response  
Jm  
1-7-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: I. HIYAMA et al.  
Serial No.: 09/270,780  
Filed: March 17, 1999  
For: LIQUID CRYSTAL DISPLAY DEVICE  
Art Unit: 2871  
Examiner: Z. Qi

RECEIVED  
JAN - 2 2003  
TECHNOLOGY CENTER 2800

PETITION AFTER FINAL REJECTION TO THE COMMISSIONER  
UNDER 37 CFR 1.181(a)(1) FOR WITHDRAWAL OF FINALITY OF  
OFFICE ACTION, ISSUANCE OF COMPLETE OFFICE ACTION,  
AND RESTARTING OF PERIOD FOR RESPONSE

Box AF  
Assistant Commissioner for Patents  
Washington, D.C. 20231

December 30, 2002

Sir:

The final Office Action dated November 27, 2002, in connection with the above-identified application is acknowledged. However, it is submitted that the finality of the Office Action of November 27, 2002, is premature and that the Office Action of November 27, 2002, is incomplete for the reasons discussed below.

It is respectfully requested that a decision on this petition be issued before the due date of February 27, 2003, for filing a response set in the Office Action of November 27, 2002.

## STATEMENT OF THE FACTS

### The Finality of the Office Action of November 27, 2002, is Premature

The Office Action of November 27, 2002, includes a new ground of rejection of claims 26, 30, and 34 under 35 USC 103(a) as being unpatentable over "the Applicant admitted prior art" in view of Gunjima et al. (Gunjima) (U.S. Patent No. 5,587,816) and Yuuki et al. (Yuuki) (U.S. Patent No. 6,147,725).

However, for the reasons discussed below, it is submitted that this new ground of rejection of claims 26, 30, and 34 set forth in the Office Action of November 27, 2002, was not necessitated by the amendment of October 24, 2002, to which the Office Action of November 27, 2002, is responsive, such that the finality of the Office Action of November 27, 2002, is premature pursuant to MPEP 706.07(a), Eighth Edition, August 2001, page 700-57, which provides as follows in pertinent part:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Claims 26, 30, and 34 respectively depend from claims 8, 15, and 21.

In the Office Action of May 24, 2002, the Examiner rejected claims 8, 15, and 21 under 35 USC 103(a) as being unpatentable over "the Applicant admitted prior art" in view of Gunjima et al. (Gunjima) (U.S. Patent No. 5,587,816) and Yuuki et al. (Yuuki) (U.S. Patent No. 6,147,725), but did not include claims 26, 30, and 34 respectively depending from claims 8, 15, and 21

in this rejection. Rather, in the Office Action of May 24, 2002, the Examiner rejected claims 26, 30, and 34 only under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

In the amendment of October 24, 2002, the applicants did not amend claims 8, 15, 21, 26, 30, and 34 (although they did amend independent claims 1, 13, and 20 from which claims 8, 15, and 21 respectively depend). Rather, the applicants presented arguments traversing the rejection of claims 8, 15, and 21 under 35 USC 103(a) set forth in the Office Action of May 24, 2002, and the rejection of claims 26, 30, and 34 under 35 USC 112, first paragraph, set forth in the Office Action of May 24, 2002.

In the Office Action of November 27, 2002, the Examiner withdrew the rejection of claims 26, 30, and 34 under 35 USC 112, first paragraph, previously set forth in the Office Action of May 24, 2002, in response to the applicants' arguments presented in the amendment of October 24, 2002.

However, in the Office Action of November 27, 2002, the Examiner repeated the rejection of claims 8, 15, and 21 under 35 USC 103(a) as being unpatentable over "the Applicant admitted prior art" in view of Gunjima et al. (Gunjima) (U.S. Patent No. 5,587,816) and Yuuki et al. (Yuuki) (U.S. Patent No. 6,147,725) previously set forth in the Office Action of May 24, 2002, and also added claims 26, 30, and 34 to this rejection.

The explanation of the rejection of claims 8, 15, and 21 under 35 USC 103(a) set forth in the Office Action of November 27, 2002, is identical to the explanation of the rejection of claims 8, 15, and 21 under 35 USC 103(a) previously set forth in the Office Action of May 24, 2002, from which it is readily apparent that the amendment of independent claims 1, 13, and 20 from which claims 8, 15, and 21 respectively depend in the amendment of October 24, 2002, had no effect whatsoever on the rejection of claims 8, 15, and 21 under 35 USC 103(a) previously set forth in the Office Action of May 24, 2002, and repeated in the Office Action of November 27, 2002.

Since the applicants did not amend claims 8, 15, 21, 26, 30, and 34 in the amendment of October 24, 2002, and the Examiner merely repeated the rejection of claims 8, 15, and 21 under 35 USC 103(a) previously set forth in the Office Action of May 24, 2002, in the Office Action of November 27, 2002, and included claims 26, 30, and 24 in this rejection, it is submitted that the Examiner could have included claims 26, 30, and 34 in the rejection of claims 8, 15, and 21 under 35 USC 103(a) set forth in the Office Action of May 24, 2002. Since the Examiner did not do this in the Office Action of May 24, 2002, but waited until the Office Action of November 27, 2002, to include claims 26, 30, and 34 in the rejection of claims 8, 15, and 21 under 35 USC 103(a), it is submitted that the new ground of rejection of claims 26, 30, and 34 under 35 USC 103(a) set forth in the Office Action of November 27, 2002, was not necessitated by the amendment of October 24, 2002, to which the Office Action of November 27, 2002, is responsive, but was necessitated by the

Examiner's failure to recognize that claims 26, 30, and 34 should have been included in the rejection of claims 8, 15, and 21 under 35 USC 103(a) set forth in the Office Action of May 24, 2002, such that the finality of the Office Action of November 27, 2002, is premature pursuant to MPEP 706.07(a) which is reproduced above.

The Office Action of November 27, 2002, is Incomplete

The Office Action of November 27, 2002, is incomplete because it does not consider the supplemental response and the Information Disclosure Statement which were filed on November 26, 2002, as evidenced by the attached copy of a post card receipt stamped by the Office of Initial Patent Examination (OIPE) acknowledging receipt of these papers on November 26, 2002.

The supplemental response of November 26, 2002, presented additional arguments traversing the rejections of claims 1-3, 5-10, 13-18, and 20-22 over the prior art set forth in the Office Action of May 24, 2002, insofar as the rejections may be deemed to be applicable to claims 1-3, 5-10, 13-18, and 20-22 as amended in the amendment of October 24, 2002, and insofar as the rejections may be deemed to be applicable to claims 25-26, 29-30, and 33-34 which were not rejected over the prior art in the Office Action of May 24, 2002.

Accordingly, it is submitted that the Examiner is required to issue a complete Office Action considering the supplemental response and the Information Disclosure Statement of November 26, 2002, and restarting the

period for response pursuant to MPEP 714.05 (Eighth Edition, August 2001, page 700-181) which provides as follows in pertinent part (emphasis by underlining added):

#### **ACTION CROSSES AMENDMENT**

A supplemental action is usually necessary when an amendment is filed on or before the mailing date of the regular action but reaches the Technology Center later. The supplemental action should be promptly prepared. It need not reiterate all portions of the previous action that are still applicable but it should specify which portions are to be disregarded, pointing out that the period for reply runs from the mailing of the supplemental action. The action should be headed "Responsive to amendment of (date) and supplemental to the action mailed (date)."

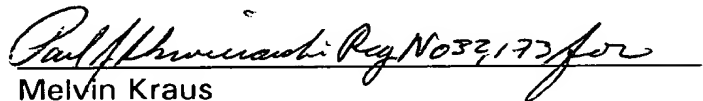
#### **RELIEF REQUESTED**

Since the finality of the Office Action of November 27, 2002, is premature for the reasons discussed above, and since the Office Action of November 27, 2002, is incomplete for the reasons discussed above, pursuant to 37 CFR 1.181(a)(1) and MPEP 706.07(c)-(d), 710.06, and 714.05, it is respectfully petitioned that the finality of the Office Action of November 27, 2002, be withdrawn; that a complete Office Action considering the

supplemental response and the Information Disclosure Statement of November 26, 2002, be issued; and that the period for response be restarted.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

  
Melvin Kraus  
Registration No. 22,466

MK/RSS  
(703) 312-6600

Attachment